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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/548,465	04/13/2000	Robert F. Bencini	15916-261	7431

7590

12/17/2003

Henricks Slavin & Holmes LLP  
840 Apollo Street  
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El Segundo, CA 90245

EXAMINER
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SIRMONS, KEVIN C

ART UNIT	PAPER NUMBER
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3763

DATE MAILED: 12/17/2003

22

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/548,465

Applicant(s)

BENCINI ET AL.

Examiner

Kevin C. Sirmons

Art Unit

3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 and 43-52 is/are pending in the application.
- 4a) Of the above claim(s) 3, 6-10 and 12-16 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2, 18, 20-26, 43-46 and 52 is/are allowed.
- 6) ☒ Claim(s) 1, 4, 5, 11, 17, 19 and 47-50 is/are rejected.
- 7) ☒ Claim(s) 51 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4, 5, 11, 17 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Stevens U.S. Pat. No. 5,419,340.

Stevens discloses an elongate body defining a proximal portion and a distal portion and a wall defining an inner surface, and outer surface and a lumen extending from the proximal portion to an aperture in the distal portion (fig. 1); a steering wire (20) having a proximal portion that extends to the proximal portion of the elongate body and a distal portion that is operably connected to the distal portion of the elongate body (20) such that proximal movement of the steering wire will result in a pulling force being applied to the distal portion of the elongate body (20); and a stiffening member associated with the distal portion of the elongate body (76) note stiffening member has no structure; and a handle, operably connected to the elongated body and to the steering wire, adapted pull the steering wire relative to the elongate body (12); as to claim 4, (fig. 1); as to claims 5 and 11, (76); as to claim 17, (figs. 1-3); as to claim 19, (fig. 1-3).

Claims 47-50 are rejected under 35 U.S.C. 102(b) as being anticipated by Ebling et al U.S. Pat. No. 4, 934,340.

Ebling discloses and elongate body 10b; a steering wire (20b), which is not connected to the anti-tear device, having a distal portion operably connected to the distal portion of the elongate body (20b); the steering wire is clearly connected to the stiffening member (24b);

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a stiffening member (24b); the examiner regards (24b) as a stiffening member since it re-enforces the elongated body; an anti-tear device (70); the examiner regards (70) as an anti-tear device because it re-enforces the interior of the elongated member even though preventing tears may not be its intended function; note: applicant has no structure for stiffening member and anti-tear device; as to claim 48, (fig. 7); as to claims 49 and 50, (figs. 7-9). **New Rejection!**

### *Response to Arguments*

Applicant's arguments with respect to claims 1, 4, 5, 11, 17 and 19 have been considered but they are not persuasive.

Independent claim 1 calls for a combination of elements including "an elongate body," "a steering wire... operably connected to the distal portion of the elongate body such that proximal movement of the steering wire will result in a pulling force being applied to the distal portion of the elongate body," "a stiffening member associated with the distal portion of the elongate body" and "a handle." The Stevens patent clearly discloses and suggests the combination.

Steven teaches that the steering wire (20) within the catheter is arranged for reciprocal movement within the distal curved portion, which when advanced, will caused the distal curved portion straighten substantially. The converse is true when the steering wire is pulled proximally. The result will be a pulling force being applied to the distal portion of the elongate body causing the distal end of the elongate body to curl or curve back to its original position. The elongated body could not be pulled back to its original curled position if there were no pulling force being applied to the distal portion of the elongate body.

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Additionally, as stated in the previous office action, the examiner maintains the fact that applicant has not given any structure to "a stiffening member." Therefore, the examiner maintains his position that (76) is a stiffening member, and that it clearly stiffens the immediate area at which it is located within the elongated body.

*Allowable Subject Matter*

Claims 2, 18, 20-26, 43-46 and 52 are allowable over the prior art of record.

Claim 51 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Conclusion*

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Kevin C. Sirmons whose telephone number is (703) 306-5410.

The examiner can normally be reached on Monday - Thursday from 6:30 am to 4:00 pm. The examiner can also be reached on alternate Fridays.

*KCS*

Kevin C. Sirmons  
Patent Examiner  
8/23/03